

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <div style="text-align: center;">480052000900</div>	
	Application Number <div style="text-align: center;">10/554,964</div>	Filed <div style="text-align: center;">October 31, 2005</div>	
	First Named Inventor <div style="text-align: center;">Jurgen DORN</div>		
	Art Unit <div style="text-align: center;">3734</div>	Examiner <div style="text-align: center;">D. D. Yabut</div>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>45,218</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p>_____ /Todd W. Wight/ Signature</p> <p>_____ Todd W. Wight Typed or printed name</p> <p>_____ (949) 251-7189 Telephone number</p> <p>_____ November 12, 2007 Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

Docket No.: 480052000900
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jurgen DORN

Application No.: 10/554,964

Confirmation No.: 1085

Filed: October 31, 2005

Art Unit: 3734

For: STENT DELIVERY SYSTEM WITH
RADIALLY STABILIZED CATHETER

Examiner: D. D. Yabut

ARGUMENTS FOR PRE-APPEAL BRIEF PANEL REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Applicant respectfully submits the following arguments in support of the Pre-Appeal Brief Request for Review filed concurrently herewith.

In a final Office Action mailed August 15, 2007 (hereinafter, "Office Action"), claims 1-5, 7-8, 10-32 and 34-36 were rejected under 35 USC § 103(a) as being unpatentable over USPAPN 2002/0016597 to Dwyer (hereinafter, "Dwyer") in view of USPN 5,690,643 to Wijay (hereinafter, "Wijay"). Claim 33 was rejected under 35 USC § 103(a) as being unpatentable over Dwyer and Wijay as applied to claim 24, and further in view of USPN 5,458,615 to Klemm. Applicant traversed these rejections.

The rejection of independent claims 1 and 24 under 35 USC § 103(a) over Dwyer in view of Wijay has been addressed by Applicant in an Amendment filed May 7, 2007 and in a

Response filed October 3, 2007. Applicant believes that the Office has failed to adequately address the primary issue raised by Applicant, thereby necessitating this appeal.

Independent claim 1 recites, *inter alia*, “the wire coil having an intermediate region with a closed-coil structure and at least one of a distal region and a proximal region with an open-coil structure.” Independent claim 24 recites, *inter alia*, “the wire coil including an open-coil structure in at least one of a proximal region and a distal region and a closed-coil structure in an intermediate region.” Thus, both claims recite the feature of an open-coil structure in at least one of a proximal region and a distal region.

The primary issue on appeal is whether the combination of references in an obviousness rejection is improper in view of an express teaching away in the primary reference of the missing element allegedly supplied by the secondary reference. More specifically, the primary issue is whether an express statement by Dwyer that the coil members have “no gaps” *during deployment* in order to transfer the compressive force from one coil member to the next, teaches away from coil members in Wijay that open only *during deployment*. Applicant respectfully submits that Dwyer clearly teaches away from Wijay and, therefore, the pending claims are patentable over the combination of Dwyer and Wijay and in immediate condition for allowance.

The justification of the Office for maintaining the obviousness rejection of Dwyer in view of Wijay, following Applicant’s response to the Office Action, is reproduced in part below:

Dwyer does not necessarily necessitate a closed-coil configuration entirely through operation since the coil is in fact flexible and may be free to bend with the delivery path (page 4, paragraph 39), which would require at least a portion of the coil to have gaps or to have an open-coil configuration...the test for obviousness...is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

(Advisory Action mailed October 23, 2007, p. 2)

Applicant respectfully submits that the position of the Office set forth in the Office Action and Advisory Action fails to address the primary issue set forth above. The issue is not whether Dwyer necessitates a closed-coil configuration *entirely through operation*, but rather whether Dwyer *teaches away* from an open coil structure allegedly described by Wijay *during deployment*. Applicant's position is that because Wijay describes a coil "in tension" prior to deployment and "open" during deployment, the relevant time period for the alleged teaching of an "open coil structure" is *during deployment*. Therefore, because Dwyer unmistakably describes "no gaps between the coil members" during deployment in order to transfer "the compressive force from one coil to the next," Dwyer expressly teaches away from the proposed combination. The relevant passages of Dwyer and Wijay are set forth below (underlining added for emphasis):

As one deploys the stent 100, tension is applied to the sheath 14 as the sheath 14 is retracted over the encapsulated stent 100. Because the stent 100 is self-expanding it is in contact with the sheath 14 and the forces are transferred along the stent 100 and to the stop 40 of the shaft 12. This results in the shaft 12 being under compressive forces. When this happens, the flexible coiled member 24 (no gaps between the coil members) transfers the compressive force from one coil to the next.

(Dwyer, paragraph [0039])

FIG. 5 is an alternative embodiment that uses a coil 36 to expand the stent 2. The coil 36 is contracted by a relative twisting between the inner tube 19 and the outer tube 6. When the coil 36 is in tension, it will have a small enough diameter to fit the stent 2 over it and secure its placement until the assembly is positioned in a body. The coil 36 is then allowed to relax, which increases its diameter and expands the stent 2. Since the coil 36 is open, it permits perfusion through annulus 30, as previously described...The end held by the doctor for the coil version shown in FIG.

5 is different from that shown in FIG. 4 to allow the doctor to apply a twist force to the inner tube 19.

(Wijay, col. 4:33-50).

Thus, it is clear from the passages reproduced above that:

- 1) Dwyer has no gaps between coils *during* deployment to transfer compressive forces caused by retraction of the sheath from over the stent;
- 2) Wijay has a closed-coil structure *prior* to deployment (contracted by relative twisting to place in tension) and an open-coil structure *during* deployment due to a release of the tension on the coil;

Therefore, there would be no suggestion to one of ordinary skill in the art to combine Dwyer with Wijay, given that the two deployment methods have an *opposite* effect on the coil member described (compression vs. relaxation). Accordingly, Dwyer teaches away from Wijay. Moreover, the substitution of the alleged “open-coil structure” of Wijay for the closed-coil structure of Dwyer *during deployment* would impermissibly change the principle of operation of Dwyer because the compressive forces could not be adequately transferred. Thus, for at least these reasons, Applicant submits that a *prima facie* case of obviousness is not established with respect to independent claims 1 and 24.

Applicant directs the panel’s attention to the specific rules and law that are pertinent to this case. According to MPEP § 2145: “[it] is improper to combine references where the references teach away from their combination (citations omitted).” (MPEP § 2145, p. 2100-160, Eighth Edition, Rev. 5, August 2006). Further, in § 2143.01, the MPEP states “[i]f the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious (citations omitted).” (MPEP § 2143.01, p. 2100-130, Eighth Edition, Rev. 5, August 2006). As discussed by the Supreme Court in the recently decided case *KSR Int’l Co. v. Teleflex, Inc.*, “when the prior art teaches away from combining certain known elements, discovery

of a successful means of combining them is more likely to be nonobvious” (550 U.S. ____ (2007), 82 USPQ2d 1385, 1395 (2007), quoting *United States v. Adams*, 383 U.S. 39, 40, 148 USPQ 479 (1966)).

In summary, Applicant respectfully submits that Dwyer expressly teaches away from the proposed modification of replacing the closed-coil structure with an open-coil structure of Wijay during deployment. Further, Applicant submits that the proposed modification would change the principle of operation of Dwyer. Accordingly, it is improper to combine Dwyer and Wijay pursuant to MPEP § 2145 and the case law with respect to rejections under 35 U.S.C. § 103. Thus, independent claims 1 and 24, and claims depending therefrom, are believed to be in immediate condition for allowance and Applicant respectfully requests that the panel pass this application to issue.

For the convenience of the panel, the Applicant’s positions are presented here in summary form. A more developed discussion of the traversal of the rejection of the pending claims under 35 U.S.C. § 103(a) as obvious over Dwyer in view of Wijay are a matter of record in the prosecution history and can be found in an Amendment filed May 7, 2007 and in a Response filed October 3, 2007, as noted above.

Dated: November 12, 2007

Respectfully submitted,

By /Todd W. Wight/
Todd W. Wight

Registration No.: 45,218
MORRISON & FOERSTER LLP
19900 MacArthur Boulevard
Irvine, California 92612-2445
(949) 251-7189